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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ASTRAZENECA R&D BOSTON 35 GATEHOUSE DRIVE WALTHAM, MA 02451-1215			BALASUBRAMANIAN, VENKATARAMAN	
			ART UNIT	PAPER NUMBER

1624

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/539,486

Applicant(s)

GRAVESTOCK ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/10/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group II, claims 1-12, 15 and 16 in the reply filed on 6/9/2006 is acknowledged. Claim 7 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject matter. Claims 1-5, 8-12, 15 and 16 will be examined to the extent they embrace the elected subject matter. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants' amendment to claims 2-12 and 15 is also acknowledged.

Information Disclosure Statement

References cited in the Information Disclosure Statement, filed on 8/10/2005, are made of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1624

Claims 1-6, 8-12, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following reasons apply. Any claim not specifically rejected is rejected as being dependent on a rejected claim.

1. Recitation of "in vivo hydrolysable ester" in claims 1, 11 and 16 is deemed as indefinite as esters or carbamates in general and as noted in specification, are compounds, which undergo in vivo hydrolysis. In that sense recitation of "in vivo hydrolysable esters" is not ambiguous and is acceptable. However, the definition of various substituent groups on C and R_{1b} include such groups, namely esters, carbamates, alkoxycarbonyl etc. which are also in vivo hydrolysable and therefore it is not clear what is the difference between these variable groups and the "in vivo hydrolysable ester" groups.

The use of ester group(s), carbamates etc as substituents on C and R_{1b} and in vivo hydrolysable ester as Markush choice, results in ambiguity.

Claims 11 and 16 recite prodrug. Prodrugs in general and as noted in specification, are compounds, which undergo in vivo hydrolysis to parent active drugs. In that sense recitation of prodrug is acceptable. However, the definition of various variable groups include such groups, namely esters, amides, alkoxycarbonyl etc. and therefore it is not clear what is the difference between these variable groups and the prodrug groups. There is clear-cut ambiguity as to what is to be considered as prodrug and what is not. Applicants should note that if the variable groups are prodrug, which are in general inactive but becomes

active upon in vivo transformation, then the compound bearing the variable group would be deemed as inactive which is not what the claim recites.

Furthermore, the issue on second paragraph is whether the structures of the claimed compounds are clearly defined. Applicants' "prodrugs" are molecules whose structure lie outside the subject matter of formula (I), but upon metabolism in the body are converted to active compounds falling within the structural scope of formula (I). The claim describes the function intended but provides no specific structural guidance to what constitutes a "prodrug". Structural formulas, names, or both can accurately describe organic compounds, which are the subject matter of claim 1. Attempting to define means by function is not proper when the means can be clearly expressed in terms that are more precise.

2. Claim 10 will become a duplicate when non-elected subject matter is removed from claim 1 leading to a double patenting rejection.
3. Claim 11 and 16 are improper dependent claims as they recite prodrug which is not recited in claim 1 on which claims 10 and 15 are dependent.
4. Regarding claim 16, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). In addition, recitation of Markush choices "salts" or "esters" in plural renders the claim indefinite as it is not clear whether a mixture of salts or esters intended.
5. The process embraced in claim 16 is also indefinite for more than one reason. In general, the process claim is vague and unclear due to usage of loose terms. For

Art Unit: 1624

example, the terms hydrogenated version, replaceable substituents, complimentary pairs of substituents suitable as complementary substrates, desired cross coupling etc., are unclear and not precise enough delineate what process is being claimed. In addition, process a is cryptic and does not precisely state what process is being claimed. The same is true for "leaving group useful in palladium coupling". It appears that one has to find out what these leaving groups are and then redeem such groups as part of instant invention without the claim actually reciting them.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 8-12, 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for making salts of the claimed compounds, does not reasonably provide enablement for making in-vivo hydrolysable of the claimed compounds. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art of medicinal chemistry - to use the invention. "The factors to be considered in making an enablement rejection have been summarized as the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in that art, the predictability or unpredictability of the art and the breadth of the claims", In re Rainer, 146 USPQ 218 (1965); In re Colianni, 195 USPQ 150, Ex parte Formal, 230 USPQ 546.

a) Finding a prodrug, in this case in vivo hydrolysable ester is an empirical exercise. Predicting if a certain ester of a claimed alcohol, for example, is in fact a prodrug, and produces the active compound metabolically, in man, at a therapeutic concentration and at a useful rate is filled with experimental uncertainty. Although attempts have been made to predict drug metabolism 'de novo, this is still an experimental science. For a compound to be a prodrug, it must meet three tests. It must itself be biologically inactive. It must be metabolized to a second substance in a human at a rate and to an extent to produce that second substance at a physiologically meaningful concentration. Thirdly, that second substance must be biologically active. Thus, determining whether a particular compound meets these three criteria in a clinical trial setting requires a large quantity of experimentation.

b) The direction concerning the prodrugs is found in the passage spanning pages 18-19

c) There is no working example of a prodrug of a compound the formula (I). d) The nature of the invention is clinical use of compounds and the pharmacokinetic behavior of substances in the human body. e) The state of the prodrug art is summarized by Wolff (Medicinal Chemistry). The table on the left side of page 976 outlines the research program to be undertaken to find a prodrug. The second paragraph in section 10 and the paragraph spanning pages 976-977 indicate the low expectation of success. In that paragraph the difficulties of extrapolating between species are further developed. Since, the prodrug concept is a pharmacokinetic issue, the lack of any standard pharmacokinetic protocol discussed in the last sentence of this paragraph is particularly relevant. Banker (Modern Pharmaceutics) in the first sentence, third paragraph on page

596 states that "extensive development must be undertaken" to find a prodrug. l) Wolff (Medicinal Chemistry) in the last paragraph on page 975 describes the artisans making Applicants' prodrugs as a collaborative team of synthetic pharmaceutical chemists and metabolism experts. All would have a Ph. D. degree and several years of industrial experience. g) It is well established that "the scope of enablement varies inversely degree of unpredictability of the factors involved", 'and physiological activity is generally considered to be an unpredictable factor. See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). h) The breadth of the claims includes all of the hundreds of thousands of compounds of formula of claim I as well as the presently unknown list potential prodrug derivatives embraced by the word "prodrug".

Thus, undue experimentation will be required to determine if any particular derivative is, in fact, a prodrug.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here. Thus, undue experimentation will be required to make Applicants' invention.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating both *Staphylococcus aureus* and *Streptococcus pneumoniae*, does not reasonably provide enablement for treating any or

all Gram-positive and Gram- negative bacterial infections generically embraced in the instant invention. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The instant method of use claim 12 is drawn to a "method for producing antibacterial effect in a warm blooded animal". Instant claim 12, as recited, is a reach through claim. A reach through claim is a claim drawn to a mechanistic, receptor binding or enzymatic functionality in general format and thereby reach through a scope of invention for which they lack adequate written description and enabling disclosure in the specification.

In the instant case, based on the inhibition of growth of selected bacteria by the instant compounds, claim 12 reaches through treating any or all bacterial infections, in general and thereby they lack adequate written description and enabling disclosure in the specification.

More specifically, in the instant case, based on the mode of action of instant compounds as inhibitor of *Staphylococcus aureus* and *Streptococcus pneumoniae* bacteria, based on limited assay with limited bacteria, it is claimed that treating any or all bacterial infections in general for which there is no enabling disclosure. Method claim 12 is not adequately enabled for treating any or all Gram-positive and Gram- negative bacterial infections generically embraced in the instant invention. From the reading of specification, it appears that the applicants are asserting that the embraced compounds because of their mode action as inhibitors of some bacteria, would be useful for treating

Art Unit: 1624

any or all Gram-positive and Gram-negative bacterial infections, for which, there is no supporting disclosure in the specification. For example, as recited, the list of bacterial infection would include gram-positive bacteria, including cocci such as *Staphylococcus* species and *Staphylococcus* species, acid-fast bacterium, including *Mycobacterium* species, bacilli, including *Bacillus* species, *Corynebacterium* species and *Clostridium* species, filamentous bacteria, including *Actinomyces* species and *Streptomyces* species', gram-negative bacteria, including cocci such as *Neisseria* species and *Acinetobacter* species, bacilli, such as *Pseudomonas* species, *Brucella* species, *Agrobacterium* species, *Bordetella* species, *Escherichia* species, *Shigella* species, *Yersinia* species, *Salmonella* species, *Klebsiella* species, *Enterobacter* species, *Haemophilus* species, *Pasteurella* species, and *Streptobacillus* species, spirochetal species, *Campylobacter* species, *Vibrio* species, and intracellular bacteria including *Rickettsia* species and *Chlamydia* species. Specific bacterial species that are targets for the antibiotics of the invention include *Staphylococcus aureus*, *Staphylococcus epidermidis*, *Staphylococcus saprophyticus*, *Streptococcus pyogenes*, *Streptococcus agalactiae*, *Streptococcus pneumoniae*, *Enterococcus faecalis*, *Enterococcus faecium*, *Bacillus anthracis*, *Mycobacterium avium*, *Mycobacterium tuberculosis*, *Acinetobacter baumannii*, *Corynebacterium diphtheriae*, *Clostridium perfringens*, *Clostridium botulinum*, *Clostridium tetani*, *Neisseria gonorrhoeae*, *Neisseria meningitidis*, *Pseudomonas aeruginosa*, *Legionella pneumophila*, *Escherichia coli*, *Yersinia pestis*, *Haemophilus influenzae*, *Helicobacter pylori*, *Campylobacter fetus*, *Campylobacter jejuni*, *Vibrio cholerae*, *Vibrio parahaemolyticus*, *Treponema pallidum*, *Actinomyces israeli*, *Rickettsia*

Art Unit: 1624

proWazekii, *Rickettsia rickettsii*, *Chlamydia trachomatis*, *Chlamydia psittaci*, *Brucella abortus*, *Agrobacterium tumefaciens*; and *Francisella tularensis*, for which there is no adequate written description and enabling disclosure.

However, there is no competent evidence in the specification that such an inhibition in the assay conditions would result in the effective treatment of any or all bacterial infections. Moreover many if not most, bacterial infections such as meningitis, anthrax etc. are very difficult to treat and at present there is no known drug, which can successfully be used to treat infectious diseases. Despite the fact there are several commercial antibacterial agents are available, it is still difficult to treat several pathogens such as those cause leprosy, meningitis, sexually transmitted infections, anthrax etc.

Note substantiation of utility and its scope is required when utility is "speculative", "sufficiently unusual" or not provided. See *Ex parte Jovanovics*, 211 USPQ 907, 909; *In re Langer* 183 USPQ 288 . Also note *Hoffman v. Klaus* 9 USPQ 2d 1657 and *Ex parte Powers* 220 USPQ 925 regarding type of testing needed to support in vivo uses.

Next, applicant's attention is drawn to the Revised Utility and Written Description Guidelines, at 66 FR 1092-1099, 2001 wherein it is emphasized that 'a claimed invention must have a specific and substantial utility'. The disclosure in the instant case is not sufficient to enable the instantly claimed method treating solely based on the inhibitory activity disclosed for the compounds. The state of the art is indicative of the requirement for undue experimentation. For bacterial infection, see Snyder et al., *J. Med. Liban* 48(4): 208-214, 2000 (PubMed Abstract provided), wherein with regards to

Art Unit: 1624

antibacterial therapies, it is stated that “ common bacteria whose susceptibility to antimicrobials is no longer predictable”. Note also that despite the fact there are several commercial antibacterial agents are available, it is still difficult to treat several pathogens such as those cause leprosy, meningitis, sexually transmitted infections, anthrax etc.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1) The nature of the invention: Therapeutic use of the compounds in treating any or all bacterial infections that require inhibiting activity of instant compound.

2) The state of the prior art: Although there are large number antibacterial agents, none of them are claimed or shown to be useful in treating any or all bacterial infections.

3) The predictability or lack thereof in the art: Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use of the instant compounds for treating any or all bacterial infections. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, “the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved”. See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

4) The amount of direction or guidance present and 5) the presence or absence of working examples: Specification has no working examples for treating any or all bacterial infections and the state of the art is that the effects of bacterial agents based on the disclosed inhibitory activity are unpredictable.

6) The breadth of the claims: The instant claims embrace any or all bacterial infections as well as millions of compounds.

7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan, regarding the pharmaceutical use, for the reasons stated above.

Thus, factors such as “sufficient working examples”, “the level of skill in the art” and “predictability”, etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of receptor-ligand interactions in general, and the lack of working examples regarding the activity of the claimed compounds towards treating variety of bacterial infections of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

MPEP 2164.01(a) states, “A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).” That conclusion is

clearly justified here. Thus, undue experimentation will be required to make Applicants' invention.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for in vitro activity of compounds shown in examples of species, does not reasonably provide enablement for large genus of compounds generically embraced in the definition of C ring and R_{1b}. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Representative examples of structurally diverse compounds generically embraced in the invention are not shown to possess in vitro activity much less in vivo uses claimed herein. Instant genus of oxazolidinone bearing pyridine-phenyl core, embrace compounds with substituents bearing plethora of structural cores and functional groups and other groups permitted at instant C and R_{1b} variables which include variously substituted heterocyclic rings with variable ring sizes and variable heteroatoms variety of reactive functional groups such COOH, OH, SH, amido, sulfoxides, sulfones nitrile, carbamates, etc. The genus embrace millions of compounds and specification has one example of the genus. There is no reasonable basis for assuming that the myriad of compounds embraced by the claims will all share the same bioactivity profile since they are so structurally dissimilar as to be chemically non-equivalent and there is no basis in the prior art for assuming the same. Note In re Surrey 151 USPQ 724 regarding sufficiency of disclosure for Markush group. Also see

Art Unit: 1624

MPEP 2164.03 for enablement requirements in cases directed to structure-sensitive art such as the pharmaceuticals.

Thus, factors such as “sufficient working examples”, “the level of skill in the art” and “predictability”, etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method of use. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of enzyme-inhibitor interactions in general, and the lack of working examples regarding the activity of the claimed compounds towards treating the variety of diseases of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, 8-12, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al., WO 01/94342.

Lee et al., teaches several oxazolidinones of formula I for treating bacterial infection, which include instant compounds, composition and method of use. In formula I shown in page 4, when R₂ is the second choice, namely pyridine (shown in page 5), the compounds taught by Lee et al., include instant compounds. See pages 5-12 for various preferred embodiments and pages 12-35 for various species made. Especially see entries 37-160 which include instant compounds. See scheme 5, page 43, for making these compounds. See page 83-159 for examples 37-160.

Claims 1-3, 6, 8-12, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Gravestock et al., US 2005/0107435.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See page 57, Example 60.

Claims 1-3, 6, 8-12, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Gadwood et al., US 2004/0072873.

Gadwood et al., teaches several oxazolidinones as intermediates infection, which include instant compounds. See pages 6-8, Scheme I and Scheme 3. See pages 9-18 for examples 1-26 wherein the step1 and step 2 include compounds claimed in the instant invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 8-12,15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al., WO 01/94342.

Teachings of Lee et al. as discussed in the above 102 rejection is incorporated herein. As noted above, Lee et al., teaches several oxazolidinones of formula I for treating bacterial infection, which include instant compounds, composition and method of use. In formula I shown in page 4, when R₂ is the second choice, namely pyridine (shown in page 5), the compounds taught by Lee et al., include instant compounds. See pages 5-12 for various preferred embodiments and pages 12-35 for various species made. Especially see entries 37-160 which include instant compounds. See scheme 5, page 43, for making these compounds. See page 83-159 for examples 37-160.

Lee et al., teaches several oxazolidinone compounds but does not exemplify all compounds generically embraced for compound of formula I wherein the phenyl and pyridine ring and the methylaminoacyl groups are variously substituted.

However, Lee et al. teaches the equivalency of those compounds exemplified with specific substituents with that generically recited on page 4 and claimed.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make oxazolidinone compounds variously substituted oxazolidinone compounds including compound substituted in the pyridine ring, phenyl ring and methylaminoacyl group as permitted by the reference and expect resulting

Art Unit: 1624

compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 8-12, 15 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11, 14 and 15 of copending Application No. 10/538,484. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims is also embraced in the copending application. Note when instant R_{24} is OR_{26} , then instant R_{1b} overlaps with $R_{1b} = NCOOR_6$ choice of the copending application.

Art Unit: 1624

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make oxazolidinone compounds variously substituted oxazolidinone compounds including compound substituted in the pyridine ring, phenyl ring and NCOOR₆ group as permitted by the copending application and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For

Art Unit: 1624

more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).


Venkataraman Balasubramanian

8/19/2006